



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/707,570

12/22/2003

Matthew S. Kissner

F-757

1569

919 7590 07/16/2009

PITNEY BOWES INC.
35 WATERVIEW DRIVE
MSC 26-22
SHELTON, CT 06484-3000

EXAMINER

ALMATRAHI, FARIS S

ART UNIT

PAPER NUMBER

3627

NOTIFICATION DATE

DELIVERY MODE

07/16/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

iptl@pb.com

Office Action Summary	Application No. 10/707,570	Applicant(s) KISSNER ET AL.	
	Examiner FARIS ALMATRAHI	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. This action is in reply to applicant communication filed March 12, 2009.
2. Claims 1-2, 4, and 9-13 have been amended.
3. Claims 17-20 have been cancelled.
4. Applicant's election of Group I – Claims 1-13 and 21-24 in the reply filed on March 12, 2009 is acknowledged. Applicant traversed the restriction arguing that the search and examination of all the claims can be made without serious burden on the examiner. This is not found persuasive because examiner needs to conduct a different field of search employing different search queries. The requirement is still deemed proper and is therefore made FINAL.
5. Claims 1-16 and 21-24 are pending examination in this application.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3627

7. **Claims 1-13 and 21-24** are rejected under 35 U.S.C 103(a) as being unpatentable over Wiebe (WO 02/39378 A1) in view of Silverbrook et al. (US Pat No. 7,222,098 B2).
8. Regarding claims 1-2, 6-7 and 21-24, Wiebe discloses a method for presenting a digital paper consolidated bill comprising: receiving data relating to a bill from a merchant (Page 23 lines 26-35); associating a digital paper pattern with a consolidated bill (Figure 4, page 23 lines 26-35); creating the digital paper bill using the data relating to the bill and the digital paper pattern; and providing the digital paper bill to a consumer (Page 23 line 29 – Page 24 line 19); receiving a payment request from the consumer, wherein the consumer uses a digital pen to process the payment request (Page 23 lines 26-35); authenticating the payment request (Page 13 line 36 – Page 14 line 4); and processing a bank payment request from a bank in order to process the payment request (Page 24 lines 5-31).
9. Wiebe fails to explicitly disclose associating a stored consumer biometric signature with the bill.
10. However, Silverbrook discloses associating a stored consumer biometric signature with the bill (Column 9 lines 3-21, Column 30 lines 3-12).
11. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Silverbrook in the device of Wiebe reference to include associating a stored consumer biometric signature with a bill in order to take advantage of current reliable technology to enhance authentication.

Art Unit: 3627

12. Regarding claim 3, Wiebe discloses a method further comprising: obtaining a consumer payment preferences record used for processing the bank payment request (Page 24 lines 26-31).
13. Regarding claim 4, Wiebe discloses a method further comprising: requesting a funds availability determination from the bank relating to the payment request (Page 24 line 32 – Page 25 line 2).
14. Regarding claim 5, Wiebe discloses a method further comprising: receiving a payment processed notice from the bank relating to the payment request (Page 24 lines 12-31, receiving back a network address of the bank's computer reads on a payment processed notice).
15. Regarding claim 8, Wiebe discloses a method wherein, the consumer uses a cellular telephone to process the payment request (Page 21 lines 28-33).
16. Regarding claim 9, Wiebe discloses a method wherein, the payment request includes an indication that the consumer used the digital pen to check an digital pen pattern box (Abstract, Page 6 line 22 – Page 7 line 2).
17. Regarding claim 10, Wiebe discloses a method wherein, the digital paper comprises a unique digital pen pattern (Page 23 line 36 - Page 24 line 4).
18. Regarding claim 11, Wiebe discloses a method wherein, the digital paper comprises a generic digital pen pattern and a payment check box including a unique digital pen pattern (Page 23 line 36 - Page 24 line 19).

Art Unit: 3627

19. Regarding claim 12, Wiebe discloses a method wherein, the payment request includes an indication that the consumer used the digital pen to write a payment amount in an digital pen pattern box (Page 20 lines 5-15, Page 24 lines 12-19).

20. Regarding claim 13, Wiebe discloses a method wherein, the payment request includes an indication that the consumer used the digital pen to check a payment dispute digital pen pattern box (Page 24 lines 5-11, invoice in question reads on payment dispute).

Response to Arguments

21. Applicant's arguments with respect to 35 U.S.C. 102(b) rejections have been considered but are moot in view of the new ground(s) of rejection.

22. In response to applicant's traversal of official notice, the examiner notes that Applicant's traversal is inadequate. MPEP 2144.03(c) requires that the applicant subsequent action adequately traverse the statement that certain subject matter is old and well known art. It further notes that an adequate traversal must state why it is believed that the subject matter is not old and well known.

MPEP 2144.03(c) states C. If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241 (“[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.”). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If

Art Unit: 3627

applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

The appellant failed to specifically point out the supposed errors in the examiner's action dated 04/23/2008, and to state why the notice fact is not considered to be common knowledge or well known in the art, therefore In view of the inadequate traversal, and in light of the requirements of 2144.03(c), ***the examiner notes that the well known in the art statements of the previous Office Action are considered to be admitted prior art.*** Furthermore the Official Notice Traversal is no longer seasonable, therefore the Official Notice is considered to be admitted prior art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 3627

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faris Almatrahi whose telephone number is (571)270-3326. The examiner can normally be reached on Monday to Friday 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Faris Almatrahi
Examiner
Art Unit 3627

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627

Application/Control Number: 10/707,570
Art Unit: 3627

Page 8